

**REMARKS****GENERAL**

On 21 October 2002, Applicant supplied amendments and comprehensive arguments in response to Office Action dated 21 June 2002. Amendments were rejected by Examiner as introducing new material, so an RCE was lodged by Applicant on 4 December 2002. The RCE requested that the amendments and arguments of the 21 October 2002 response be considered.

Applicant cannot find the "communication of Sept. 12, 2002" mentioned by the Examiner at page 10 of the present Office Action. If there was an Office Communication of that date, Applicant would appreciate a copy since we have no record of any such document being issued.

**RESTRICTION**

According to Applicant's records, the first time the issue of Restriction was raised by Examiner was the Office Action dated 21 June 2002 ("Restriction by Original Presentation"). This was the first opportunity Applicant had to respond to Examiner's restriction arguments. Notwithstanding the fact that the Office Action itself was made Final, the next action taken by Applicant was submission of an RCE. As Applicant understands it, the finality of the Office Action dated 21 June 2002 was removed by way of the RCE, resulting in the present Office Action dated 21 January 2003. As Applicant understands the situation, the opportunity to respond to the Restriction requirement is therefore the same as if it had been raised at first instance.

Applicant does not, therefore, believe that a petition under 37 CFR 1.144 is required.

Applicant has referred to MPEP 819 as suggested by Examiner, and is unable to see how this is relevant to the present situation. MPEP 819 is titled "Office Generally Does Not Permit Shift", which relates to "shifting" inventions by introducing alternative claims via an RCE that do not fall within the scope of the original claimed invention. However, Examiner is reminded that no claims were "introduced" with the RCE, since they were already on file following applicant's earlier amendment. The amendment entered via the RCE was a

relatively minor amendment rectifying minor stylistic issues with claims 87 and 138. It cannot therefore be said that there was any "shift" introduced by way of the RCE.

Moreover, Applicant submits that Examiner has provided NO opportunity for Applicant to argue against the restriction requirement without the need for a petition under 37 CFR 1.144, which is an improper denial of procedure.

Applicant requests that Examiner explain his conclusion that a petition is required as a first response to a restriction requirement, since Applicant can find no such requirement in MPEP 819 referred to by Examiner. Rather, it appears that the present situation is governed by MPEP 1.143 and 1.145. Applicant submits that an appropriate response from Examiner would have been a review of the arguments submitted in the response dated 21 October 2002 (and entered via the RCE), followed either by removal of the restriction requirement or maintenance of the requirement with an explanation. In the latter case, Applicant would then expect to file a petition under 37 CFR 1.144.

As a general point on this issue, Applicant reiterates that the classifications selected by Examiner are extremely inappropriate. Classifications seem to include everything from x-ray scanning of physical objects to optical character recognition to surveillance equipment, none of which is even hinted at by the claims or description in the present case.

**Examiner is advised that in the event the clear factual classification errors upon which the present Restriction seems to be based are not acknowledged, this matter will be taken up with the Supervising Examiner for this case.**

Moreover, if Examiner insists that a petition under 37 CFR 1.144 is filed, Applicant confirms that the arguments already set out in relation to this matter will be submitted in the form required, but in that case the manner in which Examiner has dealt with the present situation, including the gross misclassification of claims and improper reference to MPEP 819, will still be taken up with Examiner's supervisor.

#### CLAIM REJECTIONS

As for the rejection of the claims, the initial portion of the previous submission was directed to all of the independent claims, which seemed appropriate given the very substantial

overlap between them (refer to Applicant's comments in relation to restriction requirement for a very detailed explanation of this). Applicant is extremely surprised that Examiner was not able to locate the features referred to, since Applicant took particular care to use the language of the claims as far as possible when discussing features.

Applicant will first deal with Examiner's comments, then provide additional arguments directed to the individual claims.

To begin with, Applicant does not know why Examiner is referring (at page 10 of Office Action) to comments from page 2 of the response filed 7 May 2002 in relation to this case. The comments have been entirely superseded by those in Applicant's response dated 21 October 2002, which should have been reviewed by Examiner as a consequence of the RCE filed on this case.

Nevertheless, Applicant would also make the point that as well as referring to an old response, Examiner appears to have twisted the language used and quoted Applicant out of context. Examiner contends that there is no recitation in claim 1 of "printing on a card". The paragraph from which the quote was extracted does not in any way argue that printing on a card is part of the invention. Rather, the paragraph is explaining that Examiner has defined that the card is equivalent to the document (note intentional use of definite article in the claim) in the independent claims of the present application, and that Examiner then fails to make the case that a copy of the document (note definite article again) is produced by Lemelson. This is the crux of the present invention, and yet Examiner seems to be unable to understand the difference between generating some other document (eg, score results etc) based on a question card (as happens in Lemelson), and reproducing some or all of the document itself (as defined in the present invention as claimed). For some reason, Examiner has latched onto a single out-of-context quote and ignored the rest of the arguments that are in the paragraph in that earlier response.

Applicant is disappointed that Examiner appears not to have considered the comments corresponding to the same issue in the response filed 21 October 2002 on this particular point. This issue was developed considerably more to help the Examiner appreciate the subtle and important differences between the invention as claimed and Lemelson. In particular, the response of 21 October 2002 noted that:

Contrary to the Examiner's assertion on page 6 of the present office action, Lemelson does not disclose a method or system of reproducing a document. On this point, the Examiner refers to column 6, lines 5-10. However, the only printing function referred to in this context is the provision of a hard copy of "score answers or results". The "document", according to the Examiner's own interpretation of Lemelson, is the sheet 21 that is inserted into opening 14. Lemelson does not disclose reproduction of any part of *[that particular]* document 21; it only discloses printing of "a score, totalling of a score, answer to a question or a combination of such forms of information" (column 6, lines 11-13).

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This detailed explanation of the difference between Lemelson and the present invention as claimed is not mentioned in the latest Office Action, notwithstanding the fact that it clearly goes to the heart of the patentability of the present invention as defined in the independent claims. Applicant requests that Examiner explain his reasons for rejecting this argument, since nothing in the present Office Action suggests that it has even been considered.

Examiner then turns to the issue of the coded data being indicative of a position of the sensing device relative to the document. Instead of making even a perfunctory attempt at interpreting this feature in relation to any of the claims, Examiner contends that it is not clear which of the claims is being argued. With respect, Examiner's position is unsupportable. The briefest review of claim 1 (and corresponding system claim 14), for example, reveals the words "said indicating data regarding the identity of the document and a position of the sensing device relative to the document", which correspond precisely with the wording used by applicant in the arguments for which Examiner alleges he cannot identify a claim. Applicant apologises for not specifying in more detail the claims involved, but believes that very little effort was required by Examiner to ascertain at least one claim to which the argument is relevant, given that Applicant intentionally chose language corresponding precisely with that used in the relevant claims.

In any event, Examiner is now aware of claims to which argument applies, and so Applicant requests that Examiner consider the issue as argued. If Examiner needs any additional help in identifying further claims in claims 29 to 154 (assuming they are now being considered in view of comments above), Applicant will be happy to assist.

Similar arguments apply in relation to Examiners comments about page 7 and the top of page 8 of Applicant's response. Again, a quick review of the claims reveals that claim 1 (and corresponding system claim 14) defines "indicating data from a sensing device", and that the sensing device senses the indicating data "using at least some of the coded data". Applicant is not sure how Examiner could fail to associate the point being argued with the relevant claims, when identical terminology has been used to assist Examiner. Again, Applicant apologises for not being more specific about the claims to which arguments apply, but argues that this could have been figured out by Examiner with minimal effort.

At top of page 12, Examiner suggests that none of the claims incorporate the feature of the document identity and location data being used to generate a request for a copy of some or all of the document. Again, Applicant is puzzled about how Examiner cannot find this feature, since it is clearly disclosed in claims 1 and 14, again, using identical language to that used in the arguments. Claim 1 defines "indicating data" that is indicative of the "identity of the document" and a location of the sensing device relative to the document, and the identification in a computer of "a request" for a "copy of at least one page of the document". Applicant would appreciate it if Examiner would explain how he is unable to associate these features with the arguments he refers to, especially given the identical language used in both.

Turning to Examiner's comments suggesting that "there is no limitation in the independent claims which suggests a [sic] coded data identifies the location of the sensing device", Applicant directs Examiner's attention to at least claim 1, where it is defined that indicating data is "regarding... a position of the sensing device relative to the document" and that the indicating data is sensed "using at least some of the coded data". Applicant is at a loss to understand how much linguistically clearer the Examiner needs this link to be before he will accept that it is disclosed.

Before again rejecting the present claims, Applicant requests that Examiner consider carefully the difference between a magnetic strip, which is an encoding mechanism for coded data, and the coded data that is actually encoded by that mechanism. A magnetic strip is not itself "coded data", as Examiner is suggesting. It cannot be "coded data" that is indicative of anything, since it is merely a layer of magnetic material. It can, however, encode coded data that can be indicative of, for example, a document identity, as defined in many of the present claims. Again, it is only coded data that can be indicative of, for

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example, the document identity. The magnetic strip itself is indicative of nothing, since it is not coded data. *This point goes to the heart of all the present claims, and Examiner is particularly requested to offer even a prima facie case as to why this is not considered a valid position in the event the claim rejections are maintained.*

Examiner then suggests at the bottom of page 12 that Applicant is arguing a feature that does not exist in claim 2. With respect, Applicant again disagrees, and submits that Examiner's comments in this paragraph are quite convoluted and difficult to understand. In what way is Applicant considered not to be arguing a feature relevant to claim 2? Claim 2 adds that the request is associated with a zone, and that the method includes using the zone to identify the request. This is the point that is argued by Applicant in the portion referred to by Examiner.

In this case, Examiner again seems to have completely ignored the intentional and important use of the definitive article when referring to the document to be reproduced. Examiner's attention is again drawn to the fact that the present invention is concerned with reading coded data associated with a document, and generating a request for a copy of that document based on indicating data sensed via the coded data. The explanation Examiner gives of how Lemelson works admits that it is not the document that is being reproduced as a result of interaction of the card with the sensor. Rather, all that is reproduced is, for example, score sheet after the user has completed a test indicated by the card, but the matter that is printed is neither part of the document on the card (as defined by Examiner), nor is it printed in response to indicating data sensed by a sensing device in accordance with the present invention. Column 9, lines 45-50 referred to by Examiner relate explicitly to printing out of scores and results. Given that the scores and results must (by definition of the words "score" and "result", which suggest user input) be something other than the document on which the questions are located (ie, the card inserted into the reader), it seems absurd to suggest that the document (being the card, as defined by Examiner) is printed in response to anything to do with the "zone" (again, as defined by Examiner).

Examiner contends that the "zone" in Lemelson is the magnetic strip. However, claim 2 requires that the generated request be "associated" with the zone. Examiner suggests that such a relationship exists in Lemelson, but Applicant disagrees. Examiner refers to column 9, lines 41-45 as supporting his argument, but seems to have utterly ignored the relevant comments at the top of page 9 of Applicant's last response (entered via RCE). Examiner has

provided no response to the argument that the printing step in Lemelson takes place in response to user input *after* the magnetic strip is read. It cannot, therefore, be said that the print request in Lemelson is associated with the zone in any way. Again, Applicant challenges Examiner to explicitly point out where in Lemelson this feature is located. In the absence of even a prima facie position on this point, Applicant submits that Examiner's rejection of claim 2 on this basis is improper.

There is also no explanation of how the step of "identifying... from the zone relative to which the sensing device is located, the [print] request" is disclosed in Lemelson. Any printing done in Lemelson is based on user input (ie, printing of scores and results on request by user) and is not performed as a result of a print request generated on the basis of a zone relative to which a sensing device is located.

Finally, turning to Examiner's comments in relation to claim 4, Applicant does not understand why "movement" is referred to. Is Examiner talking about claim 3? Assuming so, Applicant requests that Examiner explain his position better. The parts of Figure 10 referred to by Examiner, and associated text at column 4, lines 10-17, relate only to the insertion of the card into the reader, the reading operation that takes place during insertion. In what way is this related to determining a print request based on data regarding movement of the sensing device? The only data that is read in Lemelson is computer instruction data for operating the game. There is utterly no disclosure that identification of movement within a zone in Lemelson results in a print request being generated. Again, Applicant requests that Examiner point out where this takes place, since it is certainly not disclosed in the referenced figure or text.

Examiner did not respond to Applicant's specific comments in relation to claims 4 and 5 (assuming Examiner inadvertently referred to claim 3 as claim 4). Applicant requests that Examiner respond on these points, particularly in relation to claim 5.

To assist the Examiner in understanding the situation, a number of the independent claims will now be broken down on a feature by feature basis and the relevance of Lemelson to each feature discussed:

1. *A method of providing a copy of at least one page of a printed document,*

- As far as Applicant can determine, and in accordance with Examiner's position, the only printed document disclosed in Lemelson is the card that is slid into the reader slot prior to use of the testing machine. In accordance with the language of the present claim and Examiner's interpretation of the card in Lemelson being "the document", if Lemelson is to disclose all the features of the present claim, it must necessarily disclose a method of providing a copy of the printed card based on a reading of that card. This is clearly not the case, so on this point alone Lemelson fails to disclose all the features of claim 1. The only printing Lemelson discloses is the output of score results and the like, which are not "a copy" of *the* document (card) that is inserted into the reading device of Lemelson. Examiner is reminded that this is based on his interpretation of the card in Lemelson equating to the document in claim 1 of the present case.

*the document including coded data indicative of the identity of the document and of at least one reference point of the document.*

- Examiner has reiterated that these features are disclosed in Lemelson, and Applicant again strongly rejects this conclusion.
- It is admitted that Lemelson discloses coded data indicative of an identity of the document (card) being scanned. This coded data is encoded in a magnetic strip down one side of the card. As the card is inserted, a reader in the device reads the data encoded in the magnetic strip.
- It is not the case, however, that the coded data is indicative of "at least one reference point of the document". Applicant appreciates the point Examiner is trying to make about the location of the magnetic strip being relevant to the reader's ability to read the data. However, such an interpretation is not semantically correct. The present claim defines "coded data indicative of...at least one reference point of the document". The critical words are "coded data" and "indicative". Examiner seems to be suggesting that the coded data is indicative of the reference point due to its fixed position relative to a margin. However, this interpretation confuses the "coded data" with the *medium* that encodes that data. In the case of Lemelson, the *content* of the coded data born by the *medium* of the magnetic strip is not in any way indicative of a "reference point". Examiner is referring to the *magnetic strip* as being coded data when it is in fact merely a medium for carrying coded data.



*the method including the steps of:*

*receiving, in a computer system, indicating data from a sensing device operated by a user, said indicating data regarding the identity of the document and a position of the sensing device relative to the document,*

- This feature is discussed extensively above. The indicating data in Lemelson must be the data encoded on the magnetic strip. In at least one embodiment of Lemelson, the indicating data is perhaps arguably indicative of the identity of the document. However, it is never indicative of a position of the sensing device relative to the document. Should Examiner wish to maintain this point, Applicant requests that this issue be responded to specifically, since Examiner appears not to have dealt with it yet.

*the sensing device, when placed in an operative position relative to the document, sensing the indicating data using at least some of the coded data;*

- Examiner suggest that the data in Lemelson is read from the magnetic strip in this way, although Applicant traverses such an interpretation. The sensing device is never "placed in an operative position relative to the document". Rather, the user inserts the document into the reader. There is no suggestion that these two actions are equivalent. Also, given that this is a method claim, Applicant submits that Examiner should show disclosure of this *step*, rather than relying on an unsupported proposal as to how a user might operate the device of Lemelson.

*identifying in the computer system and from the indicating data, a request for a copy of at least one page of the document; and*

- This is dealt with extensively above. Lemelson never prints a copy of a page of *the* document, where the document as defined by Examiner is the card. Accordingly, it is cannot logically follow that this feature is in any way suggested, let alone disclosed, by Lemelson.

*transmitting, from the computer system, relevant document data to at least one printer to effect printing of the copy of the at least one page.*

- Information is certainly printed in Lemelson, but as described above, it is not at least one page of *the* document from which the coded data is read.

As mentioned in the last response, claim 4 is similar in scope and defines a corresponding method from an alternate, commercially important viewpoint. Corresponding arguments apply.

5. *A method of providing a copy of at least one page of a printed document, the document including coded data indicative of a request for a copy of at least one page of the document,*

- The comments in relation to claim 1 apply here.  
*the method including the steps of:*

*receiving, in a computer system, data from a sensing device operated by a user regarding the request and regarding movement of the sensing device relative to the document,*

- Nowhere in Lemelson is it disclosed that the computer system receives "data... regarding movement of the sensing device relative to the document". Lemelson discloses that the computer system receives program data that is encoded on the magnetic strip. That data is in no way "regarding movement" as defined in this claim. The only thing it is regarding in Lemelson is program data. Examiner is requested to indicate where in Lemelson there is disclosed data read from the card that is regarding movement of the sensing device.

*the sensing device, when moved relative to the document, sensing the data regarding the request using at least some of the coded data and generating the data regarding its own movement relative to the document;*

- The request in Lemelson is generated by a user completing a test and then requesting a printout of the results. In no way is the request sensed using some of the coded data as the device is moved relative to the document.

*interpreting, in the computer system, said movement of the sensing device as designating the request;*

- There is no disclosure in Lemelson of interpreting the movement as designating the (print) request. In Lemelson, movement of the card relative to the reader is indicative of nothing and is not interpreted as anything. At best it could implicitly be interpreted as a request to read the data encoded in the magnetic strip. There is

certainly nothing in Lemelson to suggest that the movement is interpreted as a print request.

*and*

*transmitting, from the computer system, relevant document data to at least one printer to effect printing of the copy of the at least one page.*

- Again, the printed matter in Lemelson is not related to the document defined by Examiner.

6. *A method of providing a copy of at least one page of a printed document, the document including coded data indicative of an identity of the document,*

- Earlier comments apply.

*the method including the steps of;*

*receiving, in a computer system, data from a sensing device regarding an identity of a user and regarding the identity of the document and at least one page within the document, the sensing device containing the data regarding the identity of the user*

- There is no disclosure in Lemelson of the sensing device (reader) containing data regarding an identity of the user.
- There is no disclosure in Lemelson of data from the sensing device including both the identity of the document and of at least one page of the document. Examiner has suggested that column 4, lines 45-52 disclose this feature, but this is clearly not the case and Applicant does not know how Examiner has arrived at this conclusion. The section referred to is related to speech recognition, not to user recognition. Nowhere in Lemelson is there shown any case where user identity data is supplied from the sensing device to a computer system, which in turn uses that (and other) data to generate a print request.
- What is meant by Examiner's phrase "user of printer having predetermined ID"? This makes no sense in the context of the claim or the disclosure of Lemelson.
- Examiner is requested to either point out where in Lemelson there is any disclosure of user identity data being stored with the sensing device, and used in the generation of a print request as defined in this claim, or to withdraw the claim.

*and sensing the data regarding the identity of the document and the at least one page within the document using at least some of the coded data;*

- As mentioned above, Lemelson does not disclose data regarding both the identity of the document and of a page of the document.

*identifying, in the computer system from the data regarding the identity of the user and the identity of the document and the at least one page within the document, a request for a printed copy of the at least one page of the document;*

- As discussed above, Lemelson does not disclose identification of print request based on a combination of the user identity, document and at least one page of the document. Examiner is again requested to specify where these features are located or withdraw the objection.

*and*

*transmitting, from the computer system, relevant document data to at least one printer to effect printing of the copy of the at least one page.*

- The issue of precisely what data is sent to the printer for printing has been extensively covered above. Lemelson clearly fails to disclose this feature.

Other independent claims 14, 17, 18 and 19 are system claims corresponding to claims 1, 4, 5 and 6 discussed above, and similar comments apply.

Arguments relating to the other independent claims are withheld until Examiner expresses an opinion on those claims, bearing in mind that the restriction of those claims by Examiner is, in Applicant's submission, based on completely unsupportable classification of claims and improper procedure.

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Further consideration of the application is respectfully requested.

Very respectfully,

Applicant:



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